

REMARKS

Claims 21 and 33-44 were pending in the application at the time the present Office Action was mailed. Claims 39 and 40 have been amended, and no claims have been added or cancelled. Accordingly, claims 21 and 33-44 remain pending in the present application.

In the present Office Action, claim 21 was allowed and claims 33-44 were rejected. More specifically, the status of the claims in view of the present Office Action is as follows:

(A) Claims 33-35, 37 and 39 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,868,432 to Mantegazza ("Mantegazza");

(B) Claims 40, 42 and 44 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,233,340 to Sandru ("Sandru");

(C) Claims 36 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mantegazza in view of U.S. Patent No. 5,466,012 to Puckett et al. ("Puckett"); and

(D) Claims 44 and 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sandru.

A. Response to the Section 102 Rejection of Claims 33-35, 37 and 39

Claims 33-35, 37 and 39 were rejected under 35 U.S.C. § 102(b) as being anticipated by Mantegazza. The standard for anticipation under Section 102(a) requires that each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. (MPEP § 2131; emphasis added.) As explained in greater detail below, Mantegazza cannot support a Section 102 rejection of

claims 33-35, 37 and 39 for at least the reason that this reference fails to disclose or suggest each and every element as set forth in the claims.

1. Independent Claim 33 is Directed to a Voucher for Use With a Coin Discriminator that Includes, *Inter Alia*, a Visible Mark Having a First Appearance on a Substrate but a Second, Different Appearance When Photocopied

Independent claim 33 is directed to a voucher for use with a coin discriminator. The voucher includes, *inter alia*, a substrate with a visible mark. The visible mark has a first appearance on the substrate, but a photocopy of the visible mark has a second appearance, different from the first appearance. The voucher of independent claim 33 further includes an indicia which is indicative of a value for which the printed substrate can be redeemed in exchange for at least one of cash and merchandise.

2. Mantegazza Discloses a Document Having an Image Printed on the Back With Invisible Ink

As illustrated in Figures 1-3 of Mantegazza, this reference discloses a document 1 printed on a sheet-like element 2. An image 3 is printed on the sheet-like element 2 by letterpress printing. The image 3 is visible in the visible-light range. Optionally, the image 3 can be invisible in the visible-light range. (Mantegazza, column 2 at lines 14-19.)

The document 1 of Mantegazza also includes an image 10 on the backside of the sheet-like element 2. The image 10 is not visible in the visible-light range, but instead is only visible when illuminated with an ultraviolet-light lamp 11. As Mantegazza explicitly states, it is not possible for a photocopier "to photocopy the image provided on the back, since it an image not visible in the visible-light range because it is obtained with an ultraviolet-light ink." (Mantegazza, column 2 at lines 43-50.)

3. Mantegazza Cannot Support a Section 102 Rejection of Claim 33 for at Least the Reason that this Reference Fails to Disclose or Suggest a Visible Mark Having a First Appearance on a Substrate and a Second, Different Appearance When Photocopied

The coin discriminator voucher of independent claim 33 includes, *inter alia*, a visible mark which has a first appearance on a substrate and a second, different appearance when photocopied. The applicant respectfully submits that Mantegazza fails to disclose or suggest, at least, this feature. To overcome this deficiency, the Office Action suggests that the visible mark 3 taught by Mantegazza can be construed as the "visible mark" of claim 33. The applicants respectfully disagree.

Claim 33 explicitly states that "the visible mark has a first appearance on the substrate, but wherein a photocopy of the visible mark has a second appearance, different from the first appearance." Nowhere, however, does Mantegazza disclose or suggest that the image 3 changes in appearance when photocopied, as required by claim 33. Indeed, all Mantegazza states in this regard is that the image 3 is either "visible in the visible-light range" or "not visible in the visible-light range." To suggest that these attributes require that the image 3 changes when photocopied is to read something into Mantegazza which is simply not there, a practice that runs directly counter to the express requirement under Section 102 that a single prior art reference disclose or suggest each and every feature as set forth in the claim.

The invisible image 10 printed on the back of the sheet-like element 2 of Mantegazza also fails to disclose or suggest the "visible mark" of claim 33. Indeed, Mantegazza explicitly refers to the image 10 as an "invisible image" that is "not visible in the visible-light range," but is only visible "when it is illuminated with an ultraviolet-light lamp." (Mantegazza, column 2 at lines 29 and 37-39.) Furthermore, Mantegazza also states that the invisible image 10 is not only invisible before photocopying, but remains invisible when photocopied. See, for example, Mantegazza in column 2 at lines 44-50, "the photocopier, . . . is unable to photocopy the image provided on the back, since it is an

image not visible in the visible-light range" Thus, the image 10 of Mantegazza cannot reasonably be construed as having a "first appearance" on a substrate and a "second appearance, different from the first appearance" when photocopied because the appearance of the image 10 is explicitly described as not changing (i.e., it remains invisible) when photocopied.

In short, the image 3 printed on the front side of the document 1 of Mantegazza cannot reasonably be construed as the "visible mark" of claim 33 because Mantegazza does not disclose or suggest that the appearance of the image 3 changes when photocopied. In addition, the invisible image 10 on the backside of the document 1 cannot reasonably be construed as the "visible mark" of claim 33 because Mantegazza expressly states that the image 10 remains invisible both before and after photocopying. Accordingly, Mantegazza cannot support a Section 102 rejection of independent claim 33 for at least the reason that this reference fails to disclose or suggest the "visible mark" of claim 33. Therefore, the rejection of claim 33 should be withdrawn.

Claims 34, 35, 37 and 39 depend from base claim 33. Accordingly, Mantegazza cannot support a Section 102 rejection of these dependent claims for at least the reason that this reference cannot support a Section 102 rejection of corresponding base claim 33, and for the additional features of these dependent claims. Therefore, the rejection of dependent claims 34, 35, 37 and 39 should be withdrawn.

The rejection of dependent claim 34 should be withdrawn for at least one additional reason. Claim 34 states that the coin discriminator of claim 33 "is configured to receive a plurality of coins from a user and count the coins to arrive at a total." In addition, claim 34 further states that "the value indicated by the indicia printed on the substrate is related to the total." Thus, a valid 102 rejection of dependent claim 34 would require that Mantegazza disclose or suggest a voucher for use with a coin discriminator that has an indicia "related to" a total of coins counted by the coin discriminator. The applicants respectfully submit that Mantegazza fails to disclose or suggest any indicia "related to" a

total of coins counted by a coin discriminator. Accordingly, Mantegazza fails to disclose or suggest each and every element as set forth in claim 34, as is required for a proper Section 102 rejection. Therefore, the rejection of claim 34 should be withdrawn for at least this additional reason.

The rejection of claim 35 should be withdrawn for at least one additional reason as well. Claim 35 states that the indicia printed on the substrate is "related to the total" of coins counted by a coin discriminator, "but is less than the total." Again, applicants respectfully submit that Mantegazza fails to disclose or suggest a voucher for use with a coin discriminator, much less a voucher that includes an indicia "related to" a total of coins counted "but less than the total." Therefore, the rejection of dependent claim 35 should be withdrawn for at least this additional reason.

The rejection of claim 37 should also be withdrawn for at least one additional reason. Claim 37 states that the indicia printed on the substrate includes "an encrypted form of the value for which the substrate is redeemable." Applicants respectfully submit that Mantegazza does not disclose or suggest a voucher having an indicia that includes an "encrypted form of the value for which the voucher is redeemable." Therefore, Mantegazza cannot support a Section 102 rejection of dependent claim 37 for at least this additional reason, and the rejection should be withdrawn.

Dependent claim 39 recites that the visible mark on the voucher is made with a marking medium that includes fluorescent ink. Again, applicants are unable to find anywhere in the Mantegazza patent where this reference discloses printing the image 3 with fluorescent ink. Therefore, Mantegazza cannot support a Section 102 rejection of claim 39 for at least this additional reason, and the rejection should be withdrawn.

B. Response to the Section 102 Rejection of Claims 40, 42 and 44

Claims 40, 42 and 44 were rejected under 35 U.S.C. § 102(b) as being anticipated by Sandru. Independent claim 40 has been amended without commenting on or

conceding the merits of the rejection of this claim. As amended, claim 40 is directed to a voucher for use with a coin discriminator that includes, *inter alia*, a plurality of perforations formed in a substrate which define a curved pattern. The voucher further includes a visible mark that has a first appearance on the substrate but a second appearance, different from the first appearance, when photocopied. The applicants respectfully submit that Sandru fails to disclose or suggest, at least, a voucher for use with a coin discriminator that includes a visible mark which has a first appearance on a substrate but a second, different appearance, when photocopied. (Furthermore, for at least the reasons set forth above, Mantegazza fails to cure this deficiency of Sandru.) Therefore, Sandru cannot support a Section 102 rejection of independent claim 40, and the rejection should be withdrawn.

Claims 42 and 44 dependent from base claim 40. Accordingly, Sandru cannot support a Section 102 rejection of dependent claims 42 and 44 for at least the reason that this reference cannot support a Section 102 rejection of corresponding base claim 40, and for the additional features of these dependent claims. Therefore, the rejection of dependent claims 42 and 44 should be withdrawn.

C. Response to the Section 103 Rejection of Claims 36 and 38

Claims 36 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mantegazza in view of Puckett. Claims 36 and 38 depend from base claim 33. As discussed in detail above, Mantegazza fails to disclose or suggest all the features of independent claim 33. Furthermore, Puckett fails to cure the deficiencies of Mantegazza with regard to base claim 33. Accordingly, the combination of Mantegazza and Puckett cannot support a Section 103 rejection of dependent claims 36 and 38 for at least the reason that these references cannot support a Section 103 rejection of corresponding base claim 33, and for the additional features of these dependent claims. Therefore, the rejection of dependent claims 36 and 38 should be withdrawn.

D. Response to the Section 103 Rejection of Claims 41 and 43

Claims 44 and 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sandru. Claims 41 and 43 depend from base claim 40. As discussed in detail above, Sandru fails to disclose or suggest all the features of base claim 40. Accordingly, Sandru cannot support a Section 103 rejection of dependent claims 41 and 43 for at least the reason that this reference cannot support a Section 103 rejection of corresponding base claim 40, and for the additional features of these dependent claims. Therefore, the rejection of dependent claims 41 and 43 should be withdrawn.

Applicants respectfully request consideration of the present application in view of the above amendment.

Please charge any deficiency in fees or credit any overpayment to our Deposit Account No. 50-0665, under Order No. 213828013US2 from which the undersigned is authorized to draw.

Dated: November 6, 2006

Respectfully submitted

By 

Stephen E. Arnett

Registration No.: 47,392

PERKINS COIE LLP

P.O. Box 1247

Seattle, Washington 98111-1247

(206) 359-8000

(206) 359-7198 (Fax)

Attorney for Applicant